

**REMARKS/ARGUMENTS**

Claims 1-10, 12-19, 25-34, 36-43, and 49-55 are pending in this application. Claims 11 and 35 were cancelled. Claims 1, 12, 25, and 36 were amended and new claims 49-55 were added to more distinctly claim the invention. Support for the new and amended claims can be found in the specification. No new matter has been added.

**Double Patenting**

Claims 1-19 and 25-43 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6,420,108. U.S. Patent No. 6,420,108 was issued from U.S. Application Serial No. 09/020,743, and the above identified application is a continuation application of the same U.S. Application Serial No. 09/020,743. As suggested by the Examiner, these rejections can be overcome by filing a terminal disclaimer. In response, applicants will file a terminal disclaimer when other issues of patentability related to the above identified application are resolved.

**Claim Rejections Under 35 U.S.C. §§ 102 and 103**

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhao et al. Claims 25-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zhao et al. Claim 19 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. Claims 6-18 and 30-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al in view of Zhao et al.

In response to these rejections, Applicants have amended or canceled some claims. The amended independent claims 1 and 25 recite, among others, processes or instructions for receiving an input of selection of the first mark and in response to the input displaying information associated with the first expressed sequence. In contrast, neither Zhao nor Lockhart, either alone or in combination, does not disclose, teach or suggest any process or instruction for receiving an input of selection of the first mark and in response to the input displaying information associated with the first expressed sequence.

Zhao discloses a method for analyzing large numbers of cDNA plasmids from brain tissue. The Zhao method includes preparing a filter using cDNA plasmids isolated from a brain tissue sample. Zhao purified the plasmids and grided them onto a nylon membrane filter using a robot. Then, Zhao constructed probes on the filter from purified poly(A)+ RNA, again from brain tissue. Zhao then hybridized tissue samples with the filter. Then, using a Bioimaging Analyzer and an automatic quantification program, Zhao analyzed the amount of radioactivity existing at each of the probes and performed a data analysis as illustrated by a series of graphs in Fig. 3, page 211. Finally, Zhao performed sequence analysis for clones of interest. Thus, at the time of producing the graph, Zhao did not know the sequence or other characteristics of the cDNA sequences used as probes. It is after he has displayed expression levels in the graph that he proposes to conduct experiments to determine the sequence of particular probes. Zhao does not disclose, teach or suggest any process or instruction for receiving an input of selection of the first mark and in response to the input displaying information associated with the first expressed sequence.

In addition, Lockhart does not teach presenting expression level information by displaying on a first axis representing the expression level in a first sample, displaying on a second axis representing the expression level in a second sample and displaying a mark relative to the two axes. Office Action, dated July 15, 2003, page 8. Further, the Lockhart does not disclose, teach or suggest any process or instruction for receiving an input of selection of the first mark and in response to the input displaying information associated with the first expressed sequence.

Therefore neither Zhao nor Lockhart, alone or in combination, disclose, teach, or suggest any process or instruction for receiving an input of selection of the first mark and in response to the input displaying information associated with the first expressed sequence, as recited in independent claims 1 and 25 and their dependent claims. Therefore the rejections under 35 U.S.C. §§ 102 and 103 have been overcome.

New Claims

New claims 49-55 have been added to more distinctly claim the invention.

Applicants respectfully submit that neither Zhao nor Lockhart, alone or in combination, disclose, among others, receiving an input of selection of the first mark, in response to the input displaying information associated with the first expressed sequence, or in response to at least the input retrieving information associated with the first expressed sequence. Additionally, neither Zhao nor Lockhart, alone or in combination, disclose, among others, generating a sound associated with the first mark, the sound indicative of a second expression level for the first expressed sequence.

Hence the new claims 49-55 should be allowed.

Other Issues

On Information Disclosure Statements Paper Nos. 1 and 6, the Examiner indicated "date considered" to be "1/12/03," but did not initial any references on at least two pages of the Information Disclosure Statements (see Appendix for these two sheets). Applicants respectfully request the Examiner initial these references considered by the Examiner so that a clear record of prosecution history may be maintained.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Application No. 10/028,748  
Amendment dated October 14, 2003  
Amendment under 37 CFR 1.116 Expedited Procedure  
Examining Group

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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Appendix  
DM/acc/ejt  
60021048 v1

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OIP INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet

3

of

Application Number

Filing Date

First Named Inventor

Mack, David H.

Art Unit

1656

Examiner Name

J. Siew

Attorney Docket Number

018547-034810US

JCS37 U.S. PTO  
10/028748

12/21/01

## U.S. PATENT DOCUMENTS

Examiner	Cite No. <sup>1</sup>	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code <sup>2</sup> (if known)			
	AA	US 4,683,202		01/1998	Shuber	
	AB	US 5,143,854		09/1992	Pirung et al.	
	AC	US 5,206,137		04/1993	Ip et al.	
	AD	US 5,445,934		08/1995	Fodor et al.	
	AE	US 5,492,806		02/1996	Dmanac et al.	
	AF	US 5,525,464		06/1996	Dmanac et al.	
	AG	US 5,571,639		11/1996	Hubbell et al.	
	AH	US 5,593,839		01/1997	Hubbell et al.	
	AI	US 5,667,972		09/1997	Dmanac et al.	
	AJ	US 5,695,940		12/1997	Dmanac et al.	
	AK	US 5,700,637		12/1997	Southern	
	AL	US 5,707,806		01/1998	Shuber	
	AM	US 5,777,888		07/1998	Rine et al.	
	AN	US 5,871,697		02/1999	Rothberg et al.	
	AO	USSN 08/531,137		10/1995	Chee et al.	
	AP	US-SN 08/828,952			Webster et al.	
	AQ					

## FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document			Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
	AR	EPO	0 235 726		05/1989			
	AS	EPO	0 307 476 A1		03/1989			
	AT	EPO	0 392 546 A1		10/1990			
	AU	EPO	0 717 113		07/1996			
	AV	EPO	0 848 067		06/1998			
	AW	WIPO	WO89/11548		11/1989			
	AX	WIPO	WO90/15070		12/1990			
	AY	WIPO	WO92/10092		06/1992			
	AZ	WIPO	WO92/10588		06/1992			
	BA	WIPO	WO93/22456		11/1993			
	BB	WIPO	WO95/11995		05/1995			
	BC	WIPO	WO96/23078		08/1996			
	BD	WIPO	WO97/10365		03/1997			
	BE	WIPO	WO97/17317		05/1997			

Examiner  
Signature

Jeffrey Lin

Date

Considered

1/12/03

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Unique citation designation number. <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

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